

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held August 12, 2004 in the above-identified application. During the interview, Applicants' attorney discussed the various issues raised in the Office Action and why the claimed invention, as originally submitted, was patentable. Nevertheless, the discussion is moot in view of the above-discussed amendment.

The rejection of Claims 1-2 under 35 U.S.C. § 112, first paragraph, as being enabled only for substantially spherical alumina particles, but not for all alumina particle shapes, is respectfully traversed. The present invention is based on the discovery of various relations between abrasivity and alumina content with regard to the back coat layer in a magnetic recording medium comprising a non-magnetic substrate, a non-magnetic layer disposed on one surface of the non-magnetic substrate, a magnetic layer disposed on the non-magnetic layer, and a back coat layer disposed on the other surface of the non-magnetic substrate, wherein the back coat layer contains at least carbon black and alumina as non-magnetic powder. Applicants disclose in the specification that "[i]t is contemplated that such aluminas have a low relative abrasivity since they include substantial spherical particles having no acute corners." See page 7, lines 4-6. In other words, the important variable is abrasivity, not necessarily the shape of the particles. Nevertheless, in order to advance the prosecution herein, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

The rejection of Claim 1 under 35 U.S.C. § 112, first paragraph, as being enabled for only substantially spherical alumina particles having an average particle diameter of 0.15 to 0.23 μm , but not for particle sizes outside this range, is respectfully traversed. Applicants have not admitted that particles outside this range do not presently exist. Rather, Applicants have described that alumina having a higher average particle size than a commercial product

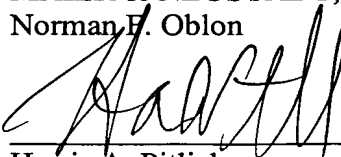
known as "TM-DR" and a low relative abrasivity, and alumina having a lower average particle size than "TM-DAR" and a low relative abrasivity, are not presently available. See the specification at page 9, second full paragraph. TM-DR has an average particle size of 0.23 μm . TM-DAR has an average particle size of 0.15 μm . See the specification at the paragraph bridging pages 8 and 9. Applicants have not, however, admitted that particles having an average particle size and low relative abrasivity could not be made with average particle sizes outside the 0.15 – 0.23 μm range. Nevertheless, in order to advance the prosecution herein, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

The rejection of Claims 1-2 under 35 U.S.C. § 102(b) as anticipated by U.S. 5,958,565 (Hattori et al), is respectfully traversed. While Hattori et al discloses a back coat layer containing carbon black and alumina, Hattori et al does not recognize the relationship between abrasivity and alumina content, as required by the present claims. Indeed, the Examiner appears to agree, in view of the suggestion of patentability herein. Accordingly, it is respectfully requested that this rejection be withdrawn.

The present claim is now in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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